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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,925	10/01/2003	Tonia Lee	W2100/280782	9598
23370 7590 04/17/2008 JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER ALAM, SHAHID AL	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 04/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,925

Applicant(s)

LEE ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 5, 6, 10, 14, 17, 18 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5, 6, 17, 18, 21-23, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 14 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Response to Applicant's **election with traverse** of Group I, claims 10, 14 and 24 – 26 for the Election/Restriction Requirements.
2. Applicant's election with traverse of Group I (claims 10, 14 and 24 – 26) in the reply filed on January 28, 2008 is acknowledged.

Applicant argues that even if the Examiner is alleging a restriction requirement between the different groups of claims identified in the Office Action, the requirement is traversed. There are three independent claims. Claim 10 is a system claim and Claims 21 and 27 are method claims. **The claims differ in scope and in the elements recited.** However, it is submitted that there is no undue burden on the Examiner to examine all of the claims concurrently. This is not found persuasive for the reasons set forth hereinbelow:

First as stated above, Applicant agrees that the claims differ in scope.

Second, with reference to **"Related Inventions"**, MPEP 808.02 states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP 806.05). If applicant optionally restricts, double patenting may be held. **Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05 (i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:**

(A) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(B) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has fulfilled his duties by providing appropriate explanation as to how the related inventions of Groups I through III are distinct **under the criteria of MPEP: 806.05(c) - 806.05(i)**. Please see below:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Species I: Claims 10, 14 and 24 – 26, drawn to determining at least one geographic area served by each of a plurality of receiver units for distributing national content to the plurality of receiver units and to generate local content, wherein the central system instructs the receiver units to generate local content that includes a

unique ID associated with the receiver unit providing the local content; and each of a subset of the end viewers served by the receiver units communicate the unique ID that was displayed and the geographic area where the unique ID was displayed to the central system and the central system determines at least one geographic areas served by each of the receiver units by associating the unique ID for each receiver unit with the geographic areas identified in the communications from the subset of the end viewers having the same unique ID.

Species II: Claims 21, 2, 5, 6, 22 and 23, drawn to determining at least one geographic area served by each of a plurality of receiver units wherein displaying the unique ID that identifies the receiver unit to a plurality of end viewers served by the receiver unit so that the ID is displayed on a television to each of the end viewers; each end viewer communicate information including the ID displayed to the end viewer and the geographic area where the ID was displayed to a central system; and identifying at least one geographic area served by the receiver unit having the particular ID.

Species III: Claims 27, 17, 18 and 28, drawn to determining at least one end user characteristic associated with a plurality of end users served by a distribution device wherein each end user within a subset of the end users to communicate information including the unique ID that was communicated to the end user and at least one end user characteristic which characterizes the end user to a central system.

The inventions are distinct, each from the other because of the following reasons:

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of

search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Besides that requiring an examiner does not seem to be in conformance with two well known Patent Goals outlined in the published Strategic Plan of the U. S. Patent and Trademark Office, available to the general public at www.uspto.gov. **The purpose of these goals is an efficient and streamlined patent process to reduce the cycle time and improve the quality of a patent issued.** The common sense is also that searching in limited and appropriate areas would turn out a prior art reference faster and thus help close the prosecution of a case earlier.

So in view of the above mentioned MPEP sections and in the spirit of fulfilling stated Patent Goals, the examiner respectfully submits that, the requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10, 14 and 24 – 26 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPU Number 2003/0212684 A1 issued to Markus Meyer et al. (hereinafter "Meyer").

With respect to claim 10, Meyer teaches a system for determining at least one geographic area served by each of a plurality of receiver units (Figure 3 and 9), comprising:

a central system for distributing national content to the plurality of receiver units and for instructing the receiver units to generate local content (see Figure 1), wherein the central system instructs the receiver units to generate local content that includes a

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unique ID associated with the receiver unit providing the local content (Paragraphs 0016 and 0018); and

the plurality of receiver units, each receiver unit serving at least one geographic area wherein each receiver unit generates local content that displays the unique ID associated with the receiver unit to a plurality of end viewers served by the receiver unit (Paragraphs 0023 and 0091);

wherein each of a subset of the end viewers served by the receiver units communicate the unique ID that was displayed and the geographic area where the unique ID was displayed to the central system and the central system determines at least one geographic areas served by each of the receiver units by associating the unique ID for each receiver unit with the geographic areas identified in the communications from the subset of the end viewers having the same unique ID (Paragraphs 0044 and 0061).

As to claim 10, each receiver unit delivers targeted programming to the end viewers it serves based on the geographic areas served by the receiver unit (Paragraphs 0075 and 0098).

As to claim 24, a central database having an entry for each receiver unit that associates the at least one geographic area served by the receiver unit with the unique ID for the receiver unit (Paragraphs 0044 and 0099).

As to claim 25, each receiver unit stores information on the at least one geographic area served by that receiver unit (Paragraph 0044).

As to claim 26, the information stored in the central database for a selected receiver unit is communicated to the selected receiver unit (Paragraph 0044).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shahid Al Alam/
Primary Examiner, Art Unit 2162

April 14, 2008